

## **REMARKS**

This paper is presented in response to the Office Action. New dependent claim 36 is added. Claims 1-36 are now pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

#### **A. Claim Amendments and/or Cancellations**

With particular reference to the claim amendments, Applicant notes that while various claims in this case have been, and/or may be, amended such amendments have been made in the interest of expediting the allowance of this case. Notwithstanding, Applicant, may, on further consideration, determine that claims of broader scope than those now presented are supported. Accordingly, Applicant hereby reserves the right to file one or more continuing applications with claims broader in scope than the claims now presented.

Consistent with the points set forth above, Applicant submits that neither the claim amendments set forth herein, nor any other claim amendments, claim cancellations or statements advanced by the Applicant in this or any related case, constitute or should be construed as, an implicit or explicit surrender or disclaimer of claim scope with respect to the cited, or any other, references.

#### **B. Remarks**

Applicant respectfully notes that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the patentable distinctions between any cited references and the invention, example embodiments of which are set forth in the claims of this application. Rather, and in consideration of the fact that various factors make it impractical to enumerate all the patentable distinctions between the invention and the cited art, as well as the fact that the Applicant has broad discretion in terms of the identification and consideration of the base(s) upon which the claims distinguish over the cited references, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration by the Applicant, in this case or any other, of: additional or alternative distinctions between the invention and the cited references; and/or, the merits of additional or alternative arguments.

Applicant notes that the remarks, or a lack of remarks, set forth herein are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the

purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

## **II. Finality Precluded in Next Action**

If the next office action rejects any of claims 1-35 using a new ground of rejection, the next office action must be non-final because, as discussed below, the Final Office Action fails to establish a *prima facie* case that claims 1-35 are obvious over the cited references. In this regard, MPEP §706.07(a) states that “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” Emphasis added.

In the present case, if the next office action rejects any of claims 1-35 using a new ground of rejection, such a rejection would not be necessitated by this response because none of the rejected claims was amended in order to distinguish over the cited references. Moreover, any such new rejection would not have been based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) because no information disclosure statement was filed and/or none was filed with the fee. Accordingly, under MPEP §706.07(a), the next Office Action must be non-final if it rejects any of claims 1-35 using a new ground of rejection.

## **III. Rejection of Claims 1-35 under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to clearly articulate the reason(s) why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. See MPEP § 2141.III. As stated by the U.S. Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_, 82 USPQ2d 1385 (2007), the analysis supporting a rejection made under 35 U.S.C. § 103 should be made explicit. Moreover, the Court also stated in *KSR* that “...[R]jections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1396.

The Examiner has rejected claims 1-35 under 35 U.S.C. § 103(a) over US Pub. No. 2003/0072059 to Thomas et al. (“*Thomas*”) in view of what the Examiner has characterized as “applicant admitted prior knowledge” (APK). Final Office Action at 2. Applicant respectfully disagrees and

submits that for at least the reasons set forth below, the rejection of claims 1-35 should be withdrawn. Of the rejected claims, claims 1, 13, 22, 25, 29, and 32 are independent claims.

**a. claims 1-21 and 25-31**

Applicant notes that the Examiner has conceded that *Thomas* does not disclose “...*authentication of the transceiver being contingent upon whether or not the transceiver has been certified by a manufacturer or supplier as meeting a specified quality standard...*” Final Office Action at 3. Likewise, in the characterization of the APK, the Examiner has neither alleged nor established that the APK discloses the aforementioned claimed “authentication.” Id. That is, the Examiner has conceded, or at least failed to establish, that neither of the cited references discloses the claimed “...*authentication of the transceiver being contingent upon whether or not the transceiver has been certified by a manufacturer or supplier as meeting a specified quality standard...*” Moreover, the Examiner has failed to explain how, in the absence of any teaching of the claimed element in the cited references, the cited references could be combined in such a way as to arrive at the claimed invention. As noted above, rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. In this instance, the Examiner has advanced no rational underpinning for the conclusion that the claims are obvious and, for at least this reason, the rejection is not well taken.

As suggested above, even if the purported disclosures of the references are combined, the resulting combination fails to include all the elements of the rejected claims, inasmuch as the Examiner has not shown that either reference discloses the claim element “...*authentication of the transceiver being contingent upon whether or not the transceiver has been certified by a manufacturer or supplier as meeting a specified quality standard...*” Moreover, the Examiner has not established that any other reference remedies this deficiency, nor has the Examiner established that the aforementioned element is encompassed either in known variations or in a principle known in the prior art. For these reasons, as well, Applicant submits that the rejection is not well taken.

Applicant notes further that with regard to combining the purported disclosures of the cited materials, the Examiner has vaguely asserted that “...it would have been obvious...to implement an authentication scheme...in the system of *Thomas*...” Id. However, the Examiner has failed to recite specifically how the Examiner believes that the system of *Thomas* would be modified by the person of ordinary skill in the art. Inasmuch as the Examiner has alleged in the Final Office Action that *Thomas* already discloses an authentication scheme (Final Office Action at 2-3), it is unclear to Applicant whether the Examiner is alleging that it would be obvious to replace, or to modify, the purported authentication scheme of *Thomas* with the alleged disclosure of APK. As noted above however, the Examiner has failed

to explain, in either event, particularly how the allegedly obvious change would be implemented. Moreover, and as discussed below, replacement or modification of the *Thomas* scheme with the alleged disclosure of the APK would likely prove problematic and, accordingly, the person of ordinary skill in the art would have no reason to undertake such a replacement or modification.

For example, if the *Thomas* authentication scheme were to be replaced with a system whereby transceiver authentication was based on whether or not the transceiver has been certified as having met a quality standard, it seems clear that the operation of the *Thomas* system would be materially compromised. Particularly, while such a replacement scheme in the *Thomas* system might arguably prevent authentication and, thus, the use, of cloned transceivers, that scheme would be ineffective in ensuring that the involved transceiver was authorized to communicate with another transceiver over the unsecured data channel to which *Thomas* refers (see, e.g., paragraph [0024]). In view of the impairment of the functionality of the *Thomas* system that would result if the authentication scheme of that system were replaced as discussed above, it is clear that the person of ordinary skill in the art would have no reason to undertake such a replacement.

If, on the other hand, the position of the Examiner is that it would be obvious to somehow modify the *Thomas* scheme to arrive at the claimed invention, it is unclear if or how such a modification could be effected without impairing the functionality of the *Thomas* scheme. For example, and as conceded by the Examiner, *Thomas* is not concerned with authentication of a particular transceiver based upon whether or not that transceiver has met a particular quality standard. Rather, *Thomas* indicates that it is concerned with a different problem, namely, “Unauthorized access to a communications channel...” See, e.g., paragraph [0057]. In view of this distinction, it is not apparent, nor has the Examiner established, that there is a reasonable expectation that the allegedly obvious modification would prove successful. Accordingly, it is not evident why the person of ordinary skill in the art would be inclined to modify the *Thomas* scheme in the allegedly obvious fashion in an attempt to arrive at the claimed invention.

As discussed above, the obviousness rejection of claims 1, 13, 25 and 29 (as well as the obviousness rejection of the respective dependent claims) lacks merit at least because the Examiner has not established that the references, when combined in the purportedly obvious fashion, disclose all the elements of the claims, and because the Examiner has failed to clearly and specifically identify the manner in which the *Thomas* scheme/system would allegedly be modified such that the claimed invention would be achieved. Applicant thus submits that the rejection of claims 1-21 and 25-31 should be withdrawn.

b. claims 22-24 and 32-35

In rejecting independent claims 22 and 32, the Examiner has alleged that “APK discloses that manufacturers and suppliers have developed strict quality standards that must be met before their fiber optic transceivers are certified... This indicates that the transceiver’s public key/private key pair should be assigned by the manufacturer to prove the transceiver authenticity.” Final Office Action at pages 7 and 9. For at least the reasons set forth below, Applicant respectfully disagrees.

For example, in the aforementioned allegation, the Examiner has simply assumed, with no analysis, evidence or rationale whatsoever, that the claimed solution necessarily follows from the problem identified in the APK. That is, the cloned transceiver problem identified in APK might admit to solution by a wide variety of different approaches, but the Examiner has completely failed to explain why, faced with that problem, the person of ordinary skill in the art would necessarily arrive at the particular solution recited in the claims. Instead, the Examiner has simply assumed, without evidence, analysis or rationale, that “...the transceiver’s public key/private key pair should be assigned by the manufacturer...” Id. Inasmuch as the rejection of claims 22 and 32 relies on conclusory statements by the Examiner, unsupported by articulated reasoning with some rational underpinning, the rejection lacks merit. Applicant thus submits that the rejection of claims 22-24 and 32-35 should be withdrawn.

#### IV. New Claim 36

By this paper, Applicant has added new dependent claim 36 which is believed to be allowable at least by virtue of its dependence from claim 1. Support for new claim 36 can be found throughout the application, including at page 4, lines 6-13.

#### V. PAYMENT OF FEES

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-36 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 25th day of February 2009.

Respectfully submitted,  
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